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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,077	03/30/2001	Akihiko Yamaguchi	NIT-275	5329
24956	7590	08/05/2004	EXAMINER	
MATTINGLY, STANGER & MALUR, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			LESNIEWSKI, VICTOR D	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/821,077	YAMAGUCHI ET AL.	
	Examiner	Art Unit	
	Victor Lesniewski	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/30/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been examined.
2. The Preliminary Amendment filed on 4/17/2001 has been placed of record in the file.
3. Claims 1-10 are now pending.

Priority

4. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 11/13/2000. It is noted, however, that applicant has not filed a certified copy of the 2000-345159 application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

5. The IDS filed on 3/30/2001 has been considered.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent Number 6,327,612) in view of Britton (U.S. Patent Number 6,591,289).
8. Watanabe disclosed an email transmission system that selectively attaches documents to different "to," "cc," and "bcc" addresses. In this way, only those recipients who need to receive

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the attachment will receive it, thus helping to resolve such issues as network congestion and memory overflow. See column 1, lines 30-37. In an analogous art, Britton disclosed a method of delivering a formatted document to a user over a communications network in several different ways, one of which being through an email attachment.

9. Watanabe did not explicitly disclose that his system could deliver an attachment that has been converted to a specific format. However, Britton's system is focused on converting an attachment into a portable document file format, or a read-only format, prior to sending an email. Since the inventions encompass the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the selective attachment system as provided by Watanabe by adding the ability to convert attachments to a specific format as provided by Britton. This would be a clear extension of Watanabe's invention because Watanabe is concerned with the problems caused when transferring an attachment to all the users in an email. In this way, Britton also makes the case that it is not ideal to send everyone in an email the same attachment. Britton points to the fact that the sender of the email may want users to be able to see the attachment without being able to modify it and thus should be able to send a formatted version to selective users. See column 2, lines 53-67.

10. Thereby, the combination of Watanabe and Britton discloses:

- <Claim 1>

An electronic mail distribution system comprising, a mail analysis means for analyzing the electronic mail to acquire all or a portion of an attached file (Watanabe, column 3, lines 15-17), a mail creation means for creating electronic mail attached with a writable file or a non-writable file according to a mail address, based on the attached file acquired

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by the mail analysis means (Watanabe, column 3, lines 17-25), and a transmission means for sending the created electronic mail (Watanabe, column 3, lines 38-40).

The reference to “non-writable file” here and below relating to Britton’s disclosure of the pdf format.

- <Claim 2>

An electronic mail distribution system according to claim 1, wherein the mail creation means attaches a file in a writable format to a main recipient address and attaches a file in a non-writable format to a copy distribution recipient addressee (Watanabe, column 2, lines 1-9 and Britton, column 4, lines 2-8).

- <Claim 3>

An electronic mail distribution system according to claim 1, wherein the mail creation means attaches a file in a writable format or a file in a non-writable format according to a domain of the mail address (Watanabe, column 4, lines 4-14).

- <Claim 4>

An electronic mail distribution system according to claim 1, wherein the file in a non-writable format is an image data format file obtained by converting contents of a writable format file to print output images, and converting the print output images to data for still images (Britton, column 4, lines 14-34).

- <Claim 5>

An electronic mail distribution system according to claim 1, wherein the mail distribution system is an electronic mail client terminal (Watanabe, column 5, lines 13-32).

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- <Claim 6>

An electronic mail distribution system according to claim 1, wherein the mail distribution system is an electronic mail server device (Watanabe, column 4, line 64 through column 5, line 12).

- <Claim 7>

An electronic mail distribution method for distributing electronic mail with an attached file, comprising the steps of, analyzing electronic mail to acquire the attached file (Watanabe, column 3, lines 15-17), making a file in a writable format or a file non-writable format file according to a mail address from the acquired attached file (Watanabe, column 3, lines 17-25), making electronic mail with a writable format file for the main recipient address and making electronic mail with a non-writable file for the copy destination recipient address (Watanabe, column 2, lines 1-9 and Britton, column 4, lines 2-8), and then sending the created electronic mail (Watanabe, column 3, lines 38-40).

- <Claim 8>

An electronic mail distribution method according to claim 7, wherein the contents of the attached file are converted to a printed output image, and the results from converting the printed output image to still image data is an image data format file (Britton, column 4, lines 14-34).

- <Claim 9>

An electronic mail distribution method according to claim 7, wherein when a non-writable format file cannot be made from the acquired attached file, a dummy file is made

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holding information notifying that the attached file currently being processed was not sent to the copy distribution addressee, and electronic mail added with the applicable dummy file is sent to the copy distribution addressee (Watanabe, column 3, lines 38-46).

- <Claim 10>

A computer-readable storage medium recorded with a program to operate the electronic mail distribution system, the medium for the system comprising, a mail analysis means utilizing a computer to analyze electronic mail by computer and acquire all or a portion of attached files (Watanabe, column 3, lines 15-17), a mail creation means for creating electronic mail attached with a writable file or a non-writable file according to a mail address, based on the attached file acquired by the mail analysis means (Watanabe, column 3, lines 17-25), and a transmission means for sending the created electronic mail (Watanabe, column 3, lines 38-40).

Since the combination of Watanabe and Britton discloses all of the above limitations, claims 1-10 are rejected.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

- Theimer et al. (U.S. Patent Number 5,493,692) disclosed a system that selectively delivers electronic messages based on the context and environment of a user.
- Kelly (U.S. Patent Number 6,442,595) disclosed an automated electronic document transmission.

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- Marchionda (U.S. Patent Number 6,628,306) disclosed a system that emails secondary recipients without attachments.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 703-308-6165. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor Lesniewski
Patent Examiner
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SUPERVISORY PATENT EXAMINER